

### REMARKS

In an Office Action mailed on June 14, 2006, claims 1, 2 and 4 were rejected under 35 U.S.C. § 102(b) as being anticipated by King; claims 29 and 31-34 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lund; claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over King in view of Strattan; claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over King in view of Ringgenberg; claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over King in view of Achee; claims 9-15, 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over King in view of Gano; claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over King and further in view of Donnelly; claims 9-15, 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over King in view of Shy; claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over King in view of Shy and further in view of Donnelly; claim 30 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lund; and claim 35 was allowed. The §§ 102 and 103 rejections are discussed below.

#### §§ 102 and 103 Rejections of Claims 1-18:

Independent claim 1 has been amended to more positively recite certain aspects of the invention. More specifically, as amended, the one-trip system of independent claim 1 includes a unit that is adapted to be run downhole into a well in a single trip. The unit includes a tubing hanger, a production tubing, a perforating gun assembly and a screen assembly. The tubing hanger is adapted to be mounted to one of the well and a well casing near the earth's surface. The production is sealingly attached to the tubing hanger and is adapted to receive a continuous medium that is riglessly deployed from the earth's surface. The perforating gun assembly is coupled to the production tubing; and the screen assembly is adapted to be engaged by the continuous medium to cause the release and movement of the screen assembly relative to the production tubing.

King fails to anticipate amended independent claim 1 for at least the reason that King fails to disclose a unit that includes a screen assembly that is adapted to be engaged by a continuous medium to cause the release and movement of the screen assembly relative to a production tubing. More specifically, King discloses a perforating/gravel pack tool 10 that has the purported purpose of completing a well 12. The tool 10 includes one or more sand screens

24 that, "are installed in the flow path between production tubing and the perforating well casing." King, 5:8-11. However, King fails to teach or even suggest that the sand screen(s) 24 are adapted to be engaged by a continuous medium that is deployed from the earth's surface for purposes of moving the screen(s) 24 relative to a production tubing. Without this disclosure, King fails to anticipate independent claim 1.

Claim 1 has been rewritten to address the Examiner's concern that claim 1 as previously written did not positively recite structure directed to the screen assembly being moved relative to the production tubing. Applicant points out that such structure is defined by the "adapted to" language of claim 1. Applicant does not desire to unnecessarily limit the scope of claim 1 by reciting additional structure to allow this screen assembly to move relative to the production tubing.

The screen assembly of claim 1 is defined at least in part by what the screen assembly does. However, "there is nothing inherently wrong with defining some part of an invention in functional terms." M.P.E.P. § 2173.05(g). Thus, "functional language does not, in and of itself, render a claim improper." M.P.E.P. § 2173.05(g); *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The Federal Circuit has held that it is improper to ignore functional language in the claim when comparing the claim to the prior art. *Pac-tec, Inc. v. Amerace Corp.*, 14 U.S.P.Q.2d. 1871, 1876 (Fed. Cir. 1990) (holding that it is improper to delete functional language from a claim in performing an invalidity determination under Section 102). Applicant also points out that the "adapted to" language does not indicate an optional feature of the screen assembly but instead limits the screen assembly to a structure that is to be engaged by a continuous medium to cause the release and movement of the screen assembly relative to a production tubing.

Therefore, for at least the reasons that are set forth above, King fails to disclose the screen assembly of claim 1 and thus, fails to anticipate this claim. As such, Applicant requests withdrawal of the §§ 102 and 103 rejections of claims 1-18.

§§ 102 and 103 Rejections of Claims 29-34:

As amended, the method of independent claim 29 recites providing a one-trip completion system that includes at least a perforating gun and a production tubing. The one-trip completion system is run downhole in a single unit using a rig. The rig is removed; and after removal of the rig, a continuous medium is run downhole into the one-trip completion system. The continuous medium actuates and operates the one-trip completion system.

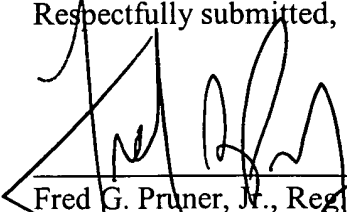
Contrary to the limitations of amended independent claim 29, Lund discloses a system/technique in which a string of production tubing is run into the well *after* a perforating and packing assembly has been positioned in the well (*emphasis added*). *See, for example*, lines 18-23 in column 8 and lines 19-23 in column 6 of Lund. Thus, Lund fails to disclose providing a one-trip completion system that includes at least a perforating gun and a production tubing; and for at least this reason, Lund fails to anticipate amended independent claim 29. As such, Applicant requests withdrawal of the §§ 102 and 103 rejections of claims 29-34.

CONCLUSION

In view of the foregoing, withdrawal of the §§ 102 and 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (SHL.0295US).

Respectfully submitted,

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